The Office Action asserts that certain limitations of the claims are subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention. Applicants respectfully disagree with this assertion and submit that the claims are indeed fully supported by the extensive disclosure.

As pointed out in the previous response, support for the features relating to the display conversion processing can at least be found on page 37 to page 38 of the present specification. Furthermore, the numerous other features cited by the Examiner as not being supported by the specification are clearly improper because such features are disclosed throughout the present specification. See for example at least, pages 43-47, pages 50-51, pages 71-73, pages 80-83, pages 85-86, pages 95-96, pages 104-107, pages 112-115, and Figs. 1, 24 and 31.

Applicants respectfully point out to the Examiner that the claimed invention subject matter need not be described literally, i.e., using the same terms, in order for the disclosure to satisfy the description requirement. As long as the specification reasonably convey to those skilled in the art that the applicants was in possession of the claimed invention as of the date of the invention, then the written description requirement is satisfied, and applicants respectfully submit that the present disclosure does indeed reasonably conveys that the applicants was in possession of the claimed invention.

Accordingly, withdrawal of the rejection of claims 1-10, 12-18, 29 and 33 under 35 U.S.C. §112, 1st paragraph is respectfully solicited.

II. THE CLAIMS DEFINE PATENTABLE SUBJECT MATTER

The Office Action rejects:

(1) claim 25 under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 5,687,332 to Kurahashi et al. (hereafter Kurahashi) in view of U.S. Patent No. 6,370,280 to Cok et al. (hereafter Cok) and U.S. Patent No. 5,933,584 to Maniwa (hereafter Maniwa);

(2) claims 29 and 33 under 35 U.S.C. §103(a) as being unpatentable over Kurahashi in view of Cok and U.S. Patent No. 5,764,235 to Hunt et al.(hereafter Hunt);

(3) claims 26, 30, 34-36, 38-43, 45-48 and 50 under 35 U.S.C. §103(a) as being unpatentable over Kurahashi in view of Cok;

(4) claims 5-7 and 13-18 under 35 U.S.C. §103(a) as being unpatentable over Hunt in view of Cok and Maniwa;

(5) claims 19, 20, 22-24, 27, 28, 31 and 32 under 35 U.S.C. §103(a) as being unpatentable over Hunt in view of Cok;

(6) claims 10 and 12 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,720,013 to Uda et al. in view of Maniwa and Cok;

(7) claim 8 under 35 U.S.C. §103(a) as being unpatentable over Hunt in view of Maniwa, Cok and Uda; and

(8) claim 49 under 35 U.S.C. §103(a) as being unpatentable over Uda in view of Maniwa, Cok and U.S. Patent No. 5,926,154 to Hirono.

These rejections are respectfully traversed.

Claim 25 Fails to be Obvious over the combination of Kurahashi, Cok and Maniwa

Applicants respectfully submit that the combination of Kurahashi, Cok and Maniwa not only fails to teach or suggest each

and every feature as set forth in the claimed invention, but there fails to be motivation for combining the three references.

In particular, the Office Action concedes that Kurahashi fails to teach or suggest that the image data is film image data and also fails to teach or suggest outputting the film image data after subjecting the film image data to display direction conversion. In an attempt to make up for the deficiencies found in Kurahashi, the Office Action has imported Cok and Maniwa.

As for Cok, the Office Action asserts that Cok teaches creating film image data to be stored in a server. However, the Office Action has failed to show where or how Cok discloses that the *information relating to the film image data* is transmitted to the image server, wherein this information relating to the film image data is used to subject the film image data to display direction conversion. Cok merely transmits a personal image 18 and image control data 28 to the image production system 14. The image control data 28 that is transmitted by Cok merely represents a personal image code identifying the image as a personal image. (see Cok, col. 4, lines 17-20). The control data 28 taught by Cok does not represent data that can be used to subject the film image data to display direction conversion.

Furthermore, applicants respectfully submit that there fails to be any motivation for combining Cok's film image data with Kurahashi's system. For example, Kurahashi is concerned with image edit processing and reducing the amount of transfer data flowing in the network. In contrast to Kurahashi, Cok is merely concerned with controlling the production of composite images and addressing the different security needs of both the individual image components and the final composite image. The Examiner asserts that there is motivation to combine Cok with Kurahashi because it

would allow the image to be created in a manner that is flexible and is usable over a wide distribution to diverse producers and the film image would have allowed users to create realistic images with low cost.

However, applicants respectfully point out that the Examiner is merely reciting Cok's objectives for its own invention. Applicants submit that from a close review of both Kurahashi and Cok, we find no teaching or suggestion to support the examiner's asserted motivation to combine the references so as to achieve the things recited above. The examiner's statement that it would allow the image to be created in a flexible manner usable over a wide distribution to diverse producers and that it would allow users to create realistic images at low cost is unsupported because the examiner has not established that the above-noted issues are a factor even recognized by Kurahashi. Kurahashi is not at all concerned with diverse producers or realistic images. Furthermore, the nature of the problems to be solved in Cok and Kurahashi are completely different.

Applicants respectfully submit that only through impermissible hindsight reconstruction using applicants' invention would one find motivation to modify the Kurahashi device to have all of the claimed features, including a film image data.

Applicants submit that the Office Action has improperly used applicants' invention as a road map to pick and choose features from different sources and paste the chosen features together to arrive at the claimed invention, even though Kurahashi and Cok does not provide any teachings, suggestion or motivation to make the modification.

As for Maniwa, the Office Action asserts that Maniwa teaches outputting images after subjecting the image to display direction

conversion. However, applicants respectfully submit that a close reading of Maniwa merely reveals that a facsimile server software has a filter function to rotate read image data before sending the image data to a print server software, and a function to automatically rotate an image when the paper feed direction in the printer is different from that of reading by the scanner, so that it is possible to easily realize a copying function. (see Maniwa, col. 29, lines 50-61). In other words, Maniwa discloses at most a rotational component for a print/copying function, not for a display function. No *display* direction conversion, as set forth in the claimed invention, is disclosed by Maniwa. Maniwa is only concerned with being able to print/copy an image according to the direction of the paper feed. Maniwa is completely silent about performing display direction conversion processing so as to *display* the image data properly. As such, applicants respectfully submit that the Office Action is inappropriately equating Maniwa's facsimile server functions directed to printing/copying with the claimed display direction conversion processing.

In the claimed invention, an image on a film is read into the input/output workstation 15. The film image data is saved as printing image data under the control of the image server 10. The longitudinal/transverse information relating to the image data is stored. The film image data is subjected to color space conversion processing and is stored as printing image data. Editing image data having a lower resolution and thumbnail image data having a still lower resolution are generated from the printing image data. The editing image data and the thumbnail image data are then subjected to display direction conversion processing so that they can be displayed in a correct direction, and are stored in

correspondence with the printing image data. (see Applicants' specification, page 37 to page 38).

In contrast to the present invention, the combination of Kurahashi, Cok and Maniwa fails to teach or suggest subjecting film image data to display direction conversion processing prior to transmitting to the client computer, as set forth in the claimed invention. Kurahashi merely discloses sending editing data information, such as resolution and color information, for display. (see Kurahashi, column 8, lines 1-3). No mention of any display direction information is taught by Kurahashi. Cok says absolutely nothing about display direction conversion processing. Further, Maniwa only discloses rotating the image data to match the paper feed direction and no display conversions are taught.

Applicants respectfully submit that independent claim 25 is allowable over the combination of Kurahashi, Cok and Maniwa for at least the reasons noted above.

Accordingly, withdrawal of the rejection of claim 25 under 35 U.S.C. §103(a) as being unpatentable over the combination of Kurahashi, Cok and Maniwa is respectfully solicited.

Claims 29 and 33 Fail to be Obvious over the combination of Kurahashi, Cok and Hunt

Applicants respectfully submit that the combination of Kurahashi, Cok and Hunt fails to teach or suggest each and every feature as set forth in the claimed invention.

In addition to the reasons noted above relating to the lack of motivation for combining Kurahashi and Cok, as conceded by the Office Action, both Kurahashi and Cok fails to teach or suggest information relating to the film image data corresponding to the type and resolution of a display device in the client computer and

the number of colors of the display device. In an attempt to make up for the deficiencies found in Kurahashi and Cok, the Office Action has imported Hunt. Specifically, the Office Action asserts that Hunt discloses transmitting information relating to the film image data corresponding to the type and resolution of a display in the client computer and the numbers of colors of the display device. (see Office Action, page 9, 2nd paragraph). Applicants disagree with this assertion.

For example, Hunt only discloses transmitting a display format which is defined merely as a display resolution. (see Hunt, col. 12, line 57). Hunt further goes on to teach that when the user intends to use the graphical image file for display on a display device, the format includes a display format suitable for the display device associated with the client machine, such as RGB, raster, vector and the like. (see Hunt, col. 12, lines 20-24). In other words, Hunt merely discloses that the transmitted display format pertains to the resolution of the display and that the display devices associated with the client machines can be RGB, raster, vector and the like. Arguably, at most Hunt suggests display format information that relates to resolution and perhaps type of display, but there is absolutely no teaching in Hunt relating to transmitting information corresponding to the number of colors of the display device, as set forth in the claimed invention. Hunt's reference to "RGB" merely indicates that a color monitor/display may be used. However, applicants point out to the Examiner that simply referencing "RGB" in no way teaches the number of colors of the display device as asserted by the Examiner. Instead, RGB merely stands for red, green, and blue color axes to form an RGB color tube. The number of colors used in a display can vary from 256 to 65K, for example, and Hunt is completely silent

about transmitting film image data corresponding to the number of colors of the display device, as set forth in claims 29 and 33.

For at least the above noted reasons, applicants respectfully submit that there fail to be motivation for combining the references and even when combined, the combination of Kurahashi, Cok and Hunt fails to teach or suggest each and every feature as set forth in the claimed invention.

Applicants respectfully submit that independent claims 29 and 33 are allowable over the combination of Kurahashi, Cok and Hunt for at least the reasons noted above.

Accordingly, withdrawal of the rejection of claims 29 and 33 under 35 U.S.C. §103(a) as being unpatentable by the combination of Kurahashi, Cok and Hunt is respectfully solicited.

Claims 26, 30, 34-36, 38-43, 45-48 and 50
Fail to be Obvious over the combination of Kurahashi and Cok

Applicants respectfully submit that not only does there fail to be proper motivation for combining Kurahashi with Cok, but even if combined, the combination of Kurahashi and Cok fails to teach or suggest each and every feature as set forth in the claimed invention.

As noted above, Kurahashi is concerned with image edit processing and reducing the amount of transfer data flowing in the network. In contrast to Kurahashi, Cok is merely concerned with controlling the production of composite images and addressing the different security needs of both the individual image components and the final composite image. The Examiner asserts that there is motivation to combine Cok with Kurahashi because it would allow the image to be created in a manner that is flexible and is usable over

a wide distribution to diverse producers and the film image would have allowed users to create realistic images with low cost.

However, applicants respectfully point out that the Examiner is merely reciting Cok's objectives for its own invention. Applicants submit that from a close review of both Kurahashi and Cok, we find no teaching or suggestion to support the examiner's asserted motivation to combine the references so as to achieve the things recited above. The examiner's statement that it would allow the image to be created in a flexible manner usable over a wide distribution to diverse producers and that it would allow users to create realistic images at low cost is unsupported because the examiner has not established that the above-noted issues are a factor even recognized by Kurahashi. Kurahashi is not at all concerned with diverse producers or realistic images. Furthermore, the nature of the problems to be solved in Cok and Kurahashi are completely different.

Applicants respectfully submit that only through impermissible hindsight reconstruction using applicants' invention would one find motivation to modify the Kurahashi device to have all of the claimed features, including a film image data.

Applicants submit that the Office Action has improperly used applicants' invention as a road map to pick and choose features from different sources and paste the chosen features together to arrive at the claimed invention, even though Kurahashi and Cok does not provide any teachings, suggestion or motivation to make the modification.

The Office Action concedes that Kurahashi does not teach that the image data is film image data. The Office Action is attempting to use Cok to import this feature. However, applicants respectfully submit that Cok merely discloses uploading film image data to an

image fulfillment server 56 and the image fulfillment server 56 produces a hardcopy of the composite image. However, no printing template film image data is transmitted from the sever 56 to the client computer, as set forth in claims 26 and 30. Cok only discloses that billing and credit information is transmitted from the fulfillment server 56. (see Cok, col. 6, lines 2-4).

Furthermore, nothing in Kurahashi whatsoever is directed to re-editing of the initially edited image. Secondly, even assuming *arguendo* that Kurahashi et al. analyze editing data (col. 7, line 3), Kurahashi still does not judge whether initial editing or subsequent re-editing is allowed based on a transmitted execution command, as claimed. In col. 6 of Kurahashi et al. (lines 45-56), all that is described are the elements and their functions of Fig. 3. None of these elements teach of subsequent re-editing in any respect, especially re-editing based on a transmitted execution command.

Applicants respectfully submit that claims 26, 30, 34-36, 38-43, 45-48 and 50 are allowable over the combination of Kurahashi and Cok for at least the reasons noted above.

Accordingly, withdrawal of the rejection of claims 26, 30, 34-36, 38-43, 45-48 and 50 under 35 U.S.C. §103(a) as being unpatentable is respectfully solicited.

Claims 5-7 and 13-18 Fail to be Obvious over Hunt, Cok and Maniwa

Applicants also respectfully submit that the combination of Hunt, Cok and Maniwa fails to make up for the deficiencies found in each individual reference, because the combination of Hunt, Cok and Maniwa fails to teach or suggest each and every feature as set forth in the claimed invention. The arguments applied above are

also applicable to the combination of Hunt, Cok and Maniwa.

For example, as noted above, Maniwa fails to teach or suggest display direction conversion processing, as set forth in the claimed invention; and Hunt fails to teach or suggest display information relating to the maximum number of colors which can be displayed on the display device. Because Hunt, Cok and Maniwa fail to make up for the deficiencies found in each individual reference, such a combination of references fail to teach or suggest each and every feature as set forth in the claimed invention.

Applicants respectfully submit that claims 5-7 and 13-18 are allowable over the combination of Hunt, Cok and Maniwa for at least the reasons noted above.

Accordingly, withdrawal of the rejection of claims 5-7 and 13-18 under 35 U.S.C. §103(a) is respectfully solicited.

Claims 19, 20, 22-24, 27, 28, 31 and 32
Fail to be Obvious over Hunt and Cok

Applicants respectfully submit that not only does the combination of Hunt and Cok fails to teach or suggest each and every feature as set forth in the claimed invention, but also that there fails to be motivation for combining Hunt and Cok.

For example, as conceded by the Office Action, Hunt fails to teach or suggest the image data is film image data. In an attempt to make up for the deficiencies in Hunt, the Office Action has imported Cok. However, Cok merely discloses that a film image can be scanned into an order entry station 50 and the order entry station 50 is connected to an image server 56 that implements an image production system 14. As such, while Hunt is concerned with a technique for transmitting graphical images in a network while the amount of data transmitted is customized in accordance with

client and/or server supplied information, Cok is merely concerned with controlling the production of composite images and addressing the different security needs involved. The transmission of Cok's film image to the image server is done without any regards to the amount of data transmitted. As such, the problems addressed by Hunt and Cok are completely different and applicants respectfully submit that one of ordinary skill in the art would not have been motivated to combine the film image data of Cok with Hunt's system. The Examiner's motivation for combining the two references is unsupported because the Examiner has not established that the realistic images and diverse producers are factors even recognized by Hunt. Hunt's factor evolves around the amount of data being transmitted. Cok is not at all concerned about the amount of data transmitted. As such, applicants respectfully submit that the Office Action has failed to provide a proper motivation for combining Cok with Hunt.

Furthermore, Hunt discloses a handshake procedure wherein the server receives a request for graphical image from the client and also receives image control information. The server determines the appropriate amount of graphical data to transmit based on the control information and transmits the appropriate amount based on the control information. However, Hunt fails to disclose the client reducing film image data and transmitting the reduced data to the server. Cok also fails to disclose any type of reduction of film image data prior to transmission.

Because Hunt and Cok fail to make up for the deficiencies found in each individual reference, such a combination of references fail to teach or suggest each and every feature as set forth in the claimed invention.

Applicants respectfully submit that claims 19, 20, 22-24, 27,

28, 31 and 32 are allowable over the combination of Hunt and Cok for at least the reasons noted above.

Accordingly, withdrawal of the rejection of claims 19, 20, 22-24, 27, 28, 31 and 32 under 35 U.S.C. §103(a) is respectfully solicited.

Claims 10 and 12 Fail to be Obvious over Uda, Maniwa and Cok

Applicants respectfully submit that the combination of Uda, Maniwa and Cok fails to make up for the deficiencies found in each individual reference, because the combination fails to teach or suggest each and every claimed feature.

Specifically, the arguments made above concerning the deficiencies found in Maniwa are equally applicable here. The Office Action concedes that Uda and Cok fails to teach or suggest outputting the film image after subjecting the film image to display direction conversion so that the film image is displayed on the display in a correct direction. The Office Action has imported Maniwa in an attempt to make up for the deficiencies found in both Uda and Cok, however, as noted above, Maniwa also fails to teach the display direction conversion, as set forth in the claimed invention.

Applicants respectfully submit that claims 10 and 12 are allowable over the combination of Uda, Cok and Maniwa for at least the reasons noted above.

Accordingly, withdrawal of the rejection of claims 10 and 12 under 35 U.S.C. §103(a) is respectfully solicited.

Claim 8 Fails to be Obvious
over Hunt, Uda, Maniwa and Cok

Applicants respectfully submit that the combination of Hunt, Uda, Maniwa and Cok fails to make up for the deficiencies found in each individual reference, because the combination fails to teach or suggest each and every claimed feature.

The arguments above pertaining to the deficiencies found in Hunt, Cok and Maniwa are also applicable to this rejection. Uda fails to make up for the above noted deficiencies noted in the combination of Hunt, Cok and Maniwa. As such, claim 8 is allowable over the combination of Hunt, Uda, Maniwa and Cok.

Accordingly, withdrawal of the rejection of claim 8 under 35 U.S.C. §103(a) is respectfully solicited.

Claim 49 Fails to be Obvious
over Uda, Maniwa, Cok and Hirono

Applicants also respectfully submit that the combination of Uda, Maniwa, Cok and Hirono fails to make up for the deficiencies found in each individual reference, because the combination still fails to teach or suggest each and every claimed feature.

The arguments made above over the combination of Maniwa, Cok and Uda are also applicable for this rejection. Because Hirono fails to make up for the deficiencies found in each of Maniwa, Cok and Uda, claim 49 is allowable over such a combination of references.

Accordingly, withdrawal of the rejection of claim 49 under 35 U.S.C. §103(a) is respectfully solicited.

II. CONCLUSION

In view of the foregoing, Applicants respectfully submit that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 **to schedule a Personal Interview**.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASH & BIRCH, LLP

By _____
D. Richard Anderson, #40,439

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

CTB
DRA/CTB/mpe
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